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EXAMINER

RUDY, ANDREW J

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL F. WHITE

Appeal 2009-1640
Application 09/678,885
Technology Center 3600

Decided:¹ February 25, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Daniel F. White (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 4-6, 9 and 10. Claims 11, 14-16, 19, and 20 have been withdrawn and claims 2, 3, 7, 8, 12, 13, 17, and 18 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention relates particularly to “electronic purchase receipts associated with electronic purchase transactions conducted in an environment of networked electronic devices, particularly computers.” Specification 2:4-5.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of processing a purchase transaction on a retail terminal, comprising the steps of:
 - acquiring purchase transaction data with a retail terminal as a result of a purchase transaction being performed on the retail terminal;
 - formatting the acquired purchase transaction data into a digital receipt with the retail terminal;
 - receiving at the retail terminal input from a person at the retail terminal that selectively

² Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Mar. 21, 2008) and Reply Brief (“Reply Br.,” filed Jul. 22, 2008), and the Examiner’s Answer (“Answer,” mailed May 22, 2008).

identifies purchase transaction datum for omission from the digital receipt;

selectively omitting the identified purchase transaction datum from the digital receipt to generate a personalized digital receipt;

forwarding the personalized digital receipt by the retail terminal over a network that is in communication with the retail terminal to a device associated with the person who identified the purchase transaction datum for omission from the digital receipt; and

transmitting the digital receipt to a storage location for a merchant.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Rodriguez

US 7,158,948 B1

Jan. 2, 2007

The Examiner also relied on Official Notice “that retail terminals used with electronic cards has been common knowledge in the art.” Answer 3.

The following rejection is before us for review:

1. Claims 1, 4-6, 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez and Official Notice.³

³ Although the statement of the rejection in the Answer (p. 3) cites only Rodriguez as prior art against the claims, Official Notice is clearly relied upon in the subsequent analysis of the rejection. See Answer 3.

ISSUES OF LAW

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1, 4-6, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez and Official Notice. The issue turns on whether Rodriguez would lead one of ordinary skill in the art to employ a “terminal” as claimed given its disclosure of using an electronic card and card reader.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 is drawn to a method of processing a purchase transaction on a retail terminal. The claimed method comprises six steps.
2. The first step of the claimed method calls for “acquiring purchase transaction data with a retail terminal as a result of a purchase transaction being performed on the retail terminal.”
3. The Specification does not provide a definition for “terminal” that is inconsistent with its ordinary and customary usage. According to the Specification (e.g., p. 12), a retail terminal encompasses “various retail terminals [that] accept payment for the goods in whatever form (i.e. cash, credit, debit, check, money order, etc.) through payment acceptor units as are known in the art such as,

cash acceptors, magnetic strip readers (MSRs), smart card readers, and the like.” Specification 12:12-15.

4. The second step of the claimed method calls for “formatting the acquired purchase transaction data into a digital receipt with the retail terminal.”
5. According to the Specification, “[t]he retail terminals may also perform formatting of the transaction data into various forms depending on the relationship/role of the retail terminal (110, 112) [referring to Fig. 1] to/with the instore processor 116. The retail terminal typically processes the transaction data into an electronic or digital form (e.g., an electronic or digital purchase transaction record) for transmission over the network 114 to the instore processor 116.” Specification 12:15-20.
6. According to the Specification, “[f]ormating and/or encoding of the transaction receipt may take many forms, of which many are known.” Specification 25:16-17.
7. An example of a digital receipt is shown in Fig. 4. “The digital receipt 160 may include the name of the merchant, retailer, store, or type of business and/or like 162 (collectively “store”) and the time and date 164. ... The receipt 160 further contains a payment area 174 that includes the mode or method of payment used by the consumer (i.e. cash, check, credit card, debit card, etc.). If necessary, an amount tendered area and change due area are also included.” Specification 26:5-19.
8. The third step of the claimed method calls for “receiving at the terminal input from a person at the retail terminal that selectively

identifies purchase transaction datum for omission from the digital receipt.”

9. According to the Specification, referring to Figs. 1 and 10, “[i]n block 306, the consumer is allowed the option of omitting or deleting certain transaction datum from the digital receipt.” Specification 37:13-15.
10. The fourth step of the claimed method calls for “selectively omitting the identified purchase transaction datum from the digital receipt to generate a personalized digital receipt.”
11. According to the Specification, referring to block 306 of Fig. 10, “the consumer is allowed to omit certain transaction datum from the digital receipt that is transmitted to him/her” Specification 37:15-16.
12. The fifth step of the claimed method calls for “forwarding the personalized digital receipt by the retail terminal over a network that is in communication with the retail terminal to a device associated with the person who identified the purchase transaction datum for omission from the digital receipt.”
13. According to the Specification, referring to Fig. 12, “[t]he digital receipt is typically transmitted to the consumer who made the purchase” Specification 39:21-22.
14. The Specification exemplifies a personal computer having a modem as a device in communication with the retail terminal (Specification 22:21) as part of in-home shopping environment (Specification 23:7-8).

15. The last step of the claimed method calls for “transmitting the digital receipt to a storage location for a merchant.”
16. According to the Specification, referring to Fig. 12, “[t]he digital receipt is typically transmitted ... the to [sic, to the] merchant who made the sale.” Specification 39:22-23.

The scope and content of the prior art

17. Rodriguez relates to electronic receipts; i.e., “electronically transferring proofs of purchase or other documents related to commercial transactions.” Col. 2, ll. 10-12.
18. Rodriguez describes a safe card (Figs. 1A-1B), an electronic card implemented in various forms such as an optical card (100 in Fig. 1A) or a smart card (Fig. 2A).
19. “A safe card is a writable/readable media whose integrity is assured through a digital signature” Rodriguez, col. 3, ll. 23-24.
20. “To read and write to the safe card, the safe card may be swiped through a read/write machine by a manual action.” Rodriguez, col. 3, ll. 27-29. “[A] safe card may also be inserted into an optical card machine in a manner similar to inserting an automated teller machine (ATM) card into an ATM, in which case the optical card machine may hold the card until the end of the transaction.” Rodriguez, col. 3, ll. 35-39.
21. Rodriguez discloses acquiring purchase transaction data as a result of a purchase transaction being performed with the safe card (col. 4, ll. 35-37 and 60-62) and formatting the acquired purchase transaction data into a digital receipt with the safe card (col. 4, ll. 45-59).

22. Rodriguez discloses input from a person at the safe card to selectively identify purchase transaction datum for omission from the digital receipt. See col. 4, ll. 47-50: “The e-receipt application on the smart card may provide the user with the ability to selectively edit and delete purchase information stored on the smart card.”
23. Rodriguez discloses a display attached to the safe card. See Fig. 2B. Also, in describing Fig. 3A, for example, which shows a data processing system depicting the use of e-receipts, the Specification states that “[t]he user receives useful information from safe card 310 through user output 314.” Col. 6, ll. 16-17.
24. Accordingly, Rodriguez discloses forwarding the digital receipt by the safe card that is in communication with the safe card to a device associated with the person who identified the purchase transaction datum for omission from the digital receipt.
25. Rodriguez discloses transmitting the e-receipt to a merchant server. Col. 6, ll. 30-35.
26. Accordingly, Rodriguez discloses transmitting a digital receipt to a merchant location.

Any differences between the claimed subject matter and the prior art

27. The claimed subject matter involves the use of a “terminal” while Rodriguez discloses the use of a safe card but otherwise Rodriguez discloses the claimed operations to form and transmit digital receipts.

The level of skill in the art

28. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of processing digital transactions. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).
29. It is within the knowledge of one of ordinary skill in the art that networks transmit digital information to displays and servers.
30. It is within the knowledge of one of ordinary skill in the art that servers store data.
31. “Applicant concedes that one of ordinary skill in the art knows that retail terminals have been used with electronic cards.” Reply Br. 2.
- Secondary considerations*
32. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*]

factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The Appellant argued claims 1, 4-6, 9 and 10 as a group (App. Br. 4-7 and Reply Br. 2-3). We select claim 1 as the representative claim for this group, and the remaining claims 4-6, 9 and 10 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellant’s major argument is that Rodriguez is directed to the use of an electronic card, not a retail terminal. See, e.g., Reply Br. 2:

Yes, Applicant concedes that one of ordinary skill in the art knows that retail terminals have been used with electronic cards. That concession, however, does not concede that the teachings of Rodriguez are immediately applicable to retail terminals as set forth in Applicant's claims. Indeed, one of the arguments made by Applicant is that the card of Rodriguez provides the ability to edit data with mechanisms on the card so why would one of ordinary skill in the art modify a terminal to do what one can already do with the card of Rodriguez?

The argument is not persuasive as to error in the rejection because the broadest reasonable construction of the claim in light of the Specification as it would be interpreted by one of ordinary skill in the art is such that the “terminal” recited in the claim encompasses the combination of the electronic card and card reader that Rodriguez discloses. “Analysis begins with a key legal question -- *what* is the invention *claimed*? Courts are

required to view the claimed invention *as a whole*. 35 U.S.C. § 103. Claim interpretation, in light of the specification, claim language, other claims, and prosecution history, is a matter of law and will normally control the remainder of the decisional process.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1987).

The Specification describes examples of terminals useful in the invention and includes “smart card readers.” FF 3. Rodriguez expressly describes smart card readers. FF 20. Accordingly, the “terminal” recited in the claim encompasses Rodriguez’s card reader.

Furthermore, the claim broadly covers any mechanism within the “terminal” for conducting the steps of the claimed method. In that regard, the method claimed is not limited so as to exclude the use of an electronic card situated in the card reader whereby card reader conducts the steps of the claimed method via the electronic card. Nowhere in the claim is there a limitation which excludes the use of electronic cards of the type that Rodriguez discloses. Nor is the method claim limited such that the recited steps could not be performed via an electronic card situated within the card reader. Given the broadest reasonable construction of the claim, the claim encompasses the use of the combination of a card reader and an electronic card, whereby the steps of the claimed method are conducted via the electronic card.

In light of this construction of the claim, because Rodriguez discloses the combination of a card reader and an electronic card, the steps of the claimed method being conducted via the electronic card, Rodriguez would lead one of ordinary skill in the art to employ a “terminal” such as the one recited in the claim.

The Appellant also argues that “What was not known was the modification of the receipt by a person, such as the customer, at the purchase site with the retail terminal before the receipt is sent to a device associated with the person who provided the modification data. Rodriguez does not enable modification of the receipt by a person, such as a customer, at the purchase site with the retail terminal before the receipt is sent to a device associated with the person who provided the modification data.” App. Br. 6. This argument is not persuasive as to error in the rejection.

As to modifying the receipt at a purchase site, this is not provided for in the claim. The claim calls for identifying purchase transaction datum for omission and selectively omitting the identified purchase transaction datum from the digital receipt and forwarding the receipt to the person identifying purchase transaction datum for omission. Rodriguez discloses acquiring purchase transaction data and providing the user with the ability to selectively edit the purchase information on the card. FF 21 and 22. Rodriguez further discloses a user output for the information on the card. FF 23. To one of ordinary skill in the art, in providing an output for information, including a receipt, on an electronic card for a user who has been given the ability to selectively edit the purchase information on the card necessarily allows the user who made the modification to receive the modified result.

For the foregoing reasons, we find that the Appellant has not shown error in the rejection of claim 1. We reach the same conclusion as to claims 4-6, 9 and 10 which have not been separately argued but which stand or fall with claim 1.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1, 4-6, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez and Official Notice.

DECISION

The decision of the Examiner to reject claims 1, 4-6, 9 and 10 is affirmed.

AFFIRMED

JRG

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